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1 RECORD OF ORAL HEARING

2
3 UNITED STATES PATENT AND TRADEMARK OFFICE

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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES

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10 *Ex Parte* FRITS JACOBUS FALLAUX,
11 ROBERT CORNELIS HOEBEN, ALEX JAN VAN DER EB,
12 ABRAHAM BOUT, and DOMENICO VALERIO

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15 Appeal 2008-2251
16 Application 10/618,526
17 Technology Center 1600

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20 Oral Hearing Held: May 22, 2008

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23 Before DONALD E. ADAMS, DEMETRA J. MILLS, and
24 JEFREY N. FREDMAN, *Administrative Patent Judges*.

25
26 ON BEHALF OF THE APPELLANTS:

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33 P R O C E E D I N G S

34 MS. BEAN: Calendar No. 47, Mr. Trask.

35 JUDGE ADAMS: Thank you.

36 MS. BEAN: You're welcome.

37 JUDGE ADAMS: Good morning, Mr. Trask.

1 MR. TRASK: Good morning.

2 JUDGE ADAMS: We are familiar with your issues, and you'll have
3 20 minutes, and if you would begin by spelling your name into the record
4 and introducing your colleagues, we'd appreciate it.

5 MR. TRASK: My name is David Trask. I have with me Richard
6 Verhage of the -- or the client I guess I should say, and my wife, Adrienne
7 Boudreau (phonetic sp.).

8 JUDGE ADAMS: Welcome. And if you wouldn't mind spelling your
9 name for us into the record.

10 MR. TRASK: T-R-A-S-K.

11 JUDGE ADAMS: Please.

12 MR. TRASK: We're here appearing today because we are of the view
13 that the MPEP, in particularly at chapter 800, section 804, is out of sync with
14 the body of case law that deals with ODP rejections.

15 JUDGE ADAMS: Um-hum.

16 MR. TRASK: I apologize for my cough which seems to be persistent
17 today. I hope I can keep it under control.

18 JUDGE ADAMS: Do you need some water? I think there is water
19 available.

20 MR. TRASK: That would be a good idea from time to time.

21 JUDGE ADAMS: Please.

22 MR. TRASK: We also are of the view that the Examiner in this case
23 has taken an approach to the two-way versus one-way analysis, which is not
24 well supported by the case law. The, the case --

25 JUDGE FREDMAN: Now why do you think that this is not an
26 appropriate one-way test situation?

1 MR. TRASK: We -- the main authority that we rely on for that
2 proposition is In Re Braat and --

3 JUDGE FREDMAN: Sure.

4 MR. TRASK: -- the cases leading up to that decision. It's critical as
5 to whether there's -- whether the one-way or two-way test is the one that
6 should be applied in a case like this because of the chart on, you know, the,
7 the 2B chart --

8 JUDGE FREDMAN: Right, yeah, but the Braat -- in re Berg tells us
9 that Braat is a pretty unusual case, and Berg says that, and I'm quoting now
10 from Berg, the two-way test is a mere exception to the general rule of the
11 one-way test. Indeed, the primary basis for the Braat decision, different
12 inventive entities, was removed by the patent law amendment of 1984.

13 And then so the question here is you have a case that was filed in '95 I
14 guess originally. The initial U.S. filing material to the 5994128 patent that
15 issued in '99 to the same inventive entity as currently being claimed. So the
16 reason why, why the Patent Office dictated the rate of prosecution, in other
17 words, why could you not have filed this claim in the 08793170 filing?

18 MR. TRASK: Well, the primary reason is that it's different inventors,
19 and there isn't any way you can do that --

20 JUDGE FREDMAN: The, the inventorship between that -- this patent
21 and yours is the same. Your, your specification says that it's a continuation
22 of 10219414 which is continuation, which is a divisional, which is a
23 continuation of 08793170 filed March 25th, 1997.

24 MR. TRASK: Yes, but the ownership of these inventions is, is
25 different. I think there was --

1 JUDGE FREDMAN: I'm not asking ownership right now. I'm
2 asking --

3 MR. TRASK: Yeah.

4 JUDGE FREDMAN: -- pace dictation. In other words, could you not
5 have filed this claim in the 1997 application?

6 MR. TRASK: My understanding is no.

7 JUDGE FREDMAN: Why?

8 MR. TRASK: Just because there was no authority to do it. It
9 wouldn't have had the proper inventorship to do it and, and you didn't have
10 the proper ownership --

11 JUDGE FREDMAN: The, the specification of the current case,
12 because it's a straight divisional continuation, must be identical to the 1997
13 filing.

14 MR. TRASK: Well --

15 JUDGE FREDMAN: So to the extent that this case is -- your current
16 claim is supported by the current specification, it must have been supported
17 by the original specification, right? And that's for --

18 MR. TRASK: Well, that's true. I, I --

19 JUDGE FREDMAN: -- black-letter law.

20 MR. TRASK: -- wouldn't debate that. I --

21 JUDGE FREDMAN: So if you could have filed it then, I don't see
22 why you couldn't file it now. In other words, if that entire disclosure was
23 disclosed here in the 1997 filing, why could it not have been claimed in the
24 1997 filing?

1 MR. TRASK: Well, I, I don't know how to answer that other than I've
2 answered it, that, that the -- that it wouldn't have been appropriate
3 considering actual ownership of, of these technologies --

4 JUDGE FREDMAN: Okay, but that's not dictated by the Patent
5 Office. That's been dictated by the applicants.

6 MR. TRASK: Well, it's dictated by business I guess. I, I don't think
7 the applicant --

8 JUDGE FREDMAN: Right, but in other words, the in, the --

9 MR. TRASK: -- in this case could dictate it --

10 JUDGE FREDMAN: -- in re Braat situation was a situation for one --
11 the one -- an application of the two-way test where the delays were due to
12 Patent Office issues. In other words, the problems dictated by the Patent
13 Office here, what I hear you telling me, and maybe I'm misstating it, is that
14 the choice of when to file this claim was dictated by the ownership issues of
15 the applicant and not by any rate of prosecution --

16 MR. TRASK: Yeah.

17 JUDGE FREDMAN: -- by the Patent Office, not any by delays by the
18 Examiner, none of those problems.

19 MR. TRASK: No, I, I wouldn't disagree with, with what you're
20 saying.

21 JUDGE FREDMAN: Okay.

22 MR. TRASK: What, what I do take some issue with is that in fact the,
23 the control by the PTO has really been in fact that big a factor in these
24 decisions. I know that in the manual that the case law is, is summarized in
25 that fashion as though the, the test of interest is whether the PTO in fact did

1 something to delay the issuance of the patents. I don't, I don't find that
2 specifically in any of those cases.

3 JUDGE FREDMAN: I think Berg pretty much says that.

4 MR. TRASK: Berg says it doesn't even need to get to that issue,
5 because in fact in Berg the, the -- they determined that everything could
6 have been filed in the same case, and so they never got down to the, to the
7 issue of whether there was some sort of a delay by the Patent Office. There
8 is some dicta in Berg that, that deals with that dichotomy, but for purposes
9 of that decision, that wasn't even a relevant factor.

10 JUDGE FREDMAN: But Berg does say we base our affirmance (sic)
11 on the second stated rationale of the Board. Because Berg could have filed
12 the claims of its separate applications in a single application, and it simply
13 chose to file two applications as made in the identical disclosures, Berg is
14 not entitled to the two-way test.

15 Here, I don't see why you couldn't have filed this in the 08793170
16 case that issued in 1999 and filed in '97. So I think that that is consistent
17 with the, the rationale of the federal circuit in Berg.

18 MR. TRASK: Well, Berg and, and actually both the decisions in
19 chapter 800, involved situations in which there was really one applicant
20 involved and where there was a cure for whatever, whatever happened, the
21 outcome of those decisions, whether it was a one-way or two-way test, there
22 was always a cure for the applicant which was filed a terminal disclaimer,
23 and that resolved the issue. So --

24 JUDGE FREDMAN: And here you don't have that cure. That's quite
25 clear --

1 MR. TRASK: Here we don't have that. Here the question has to be
2 whether applicants in a specific situation inevitably find themselves in a
3 black hole from which there is just no escape.

4 Now for a double patenting, the ODP doctrine which purports to be an
5 equitable doctrine, and I have to say this must be an unintended
6 consequence. There isn't any way to believe that, that there is some grand
7 public policy reason which dictates this result, and I do think that --

8 JUDGE FREDMAN: Well, I mean the, the public policy reason that
9 we're aware of, and I'm sure you're aware of it as well, is the idea that you
10 don't have differing ownership and presumably harassment by multiple
11 assignees, and that's the, the second stated reason that's always been given
12 for the ODP rejections.

13 MR. TRASK: Well, it's -- again, I, I don't disagree that when you
14 read the case law that those words will appear here and there that -- and
15 besides we, we have this perceived evil that can be avoided but as -- we tried
16 to, we tried to give you a coherent brief --

17 JUDGE FREDMAN: Oh, no, you gave us --

18 MR. TRASK: -- that, that laid out why that doesn't make much sense
19 in this case.

20 Now the tiny, tiny population of people that could possibly fall in, in
21 the situation that this applicant are the only ones who somehow this policy
22 prohibits from harassing allegedly litigants, and I can't see how the Patent
23 Office could ever discipline that effectively. It, it just isn't equipped to do
24 that.

1 JUDGE FREDMAN: I guess it was -- you point out in your brief the
2 list of authorities and how we are -- based on SOP2, we are not bound by the
3 MPEP.

4 MR. TRASK: Yes.

5 JUDGE FREDMAN: I mean this, this concept comes from Van
6 Ornum (phonetic sp.), I think, and that's a federal circuit case, and it's a little
7 unclear to me how we're not bound by Van Ornum.

8 MR. TRASK: Well, I don't think you are technically bound by Van
9 Ornum, because it's not a panel decision case. You did also cite in the, in
10 the opening brief the, the standard operating procedure that, that binds you
11 but --

12 JUDGE FREDMAN: Right. No, you did. You had that --

13 MR. TRASK: -- which makes it clear that, that actually panel
14 decisions of the federal circuit are not binding on this Board, and why
15 should they be? There's -- there isn't any logical reason why they, why they
16 would be. Certainly an en banc decision or when the federal circuit
17 specifically says that it should be binding, I think --

18 JUDGE FREDMAN: Right.

19 MR. TRASK: -- presumably those are binding but, but not the
20 ordinary panel and, and it's notoriously known by even by the members on
21 the federal circuit that the outcome of a particular case depends very much
22 on the, the panel they happen to get. So under those circumstances, and
23 certainly I don't think anybody would contend that there is a greater level of
24 expertise on the federal circuit than there is on this Board. Again, it defies
25 logic to, to believe that.

1 So I think if this Board sees a policy reason that, that would correct
2 this really unfortunate situation that the power is here to do it. The authority
3 is here to do it, and I don't think it's going to disrupt anything to do it. It just
4 -- it's curing an ill.

5 JUDGE FREDMAN: Thank you.

6 MR. TRASK: I appreciate --

7 JUDGE ADAMS: Anything --

8 MR. TRASK: -- your questions and I -- yeah, there's some more?

9 JUDGE ADAMS: No, no, I was just -- is -- anything else you wanted
10 to present to us?

11 MR. TRASK: Well, I, I was prepared to present more, but I, I think
12 from the flavor of this exchange that probably what I was going to present
13 has, has one way or another been presented if, if you're satisfied with it
14 and --

15 JUDGE FREDMAN: Okay.

16 JUDGE ADAMS: Okay. Any further questions?

17 JUDGE MILLS: I just have one last question. You don't have any
18 issue that there is a clear genus species situation --

19 MR. TRASK: No, we don't have any --

20 JUDGE MILLS: -- between the patent --

21 MR. TRASK: -- art issues to bring. We do -- I would say I'd, I'd
22 make one more point. I do think that, that it's not surprising to see the, the
23 manual maybe getting ahead of the curve, because after all, these cases come
24 up as little micro-instances in, in a greater universe of ODP rejections and
25 so, so there is a little bit of information in this case, little bit of information
26 in that case. Now the manual has the job of bringing this all together and

1 instructing the Examiners concerning the, the total picture. It would, it
2 would be surprising if there, if there weren't situations where the manual was
3 directing examiners to do something which in this case I frankly feel they
4 don't want to do. But, but they, they must be obedient to the manual. This
5 Board doesn't have that restriction.

6 JUDGE ADAMS: Any further questions --

7 JUDGE MILLS: No other questions.

8 MR. TRASK: Thank you.

9 JUDGE ADAMS: Thank you very much for your time.

10 JUDGE FREDMAN: Thank you.

11 (Whereupon, the hearing concluded on May 22, 2008.)
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